

II. RESPONSE TO OFFICE ACTION

The Office Action rejected Claims 1-5 and 16 and objected to claims 6-15. Reconsideration of the claims in light of the above amendment and the following remarks is respectfully requested. The Examiner's comments from the Office Action are reprinted below in 10-point bold type and are followed by Assignee's remarks.

A. Election/Restrictions

1. Applicant's election without traverse of Group 1, claims 1-17 in the reply filed on 12/30/2005 is acknowledged.

2. Claims 18-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 12/30/2005.

Assignee expressly reserves the right to pursue additional claims in subsequent application(s).

B. Claim Rejections

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Creighton (US 2,128,352). The claimed structure reads exactly on the embodiment shown in figures 9-10 of Creighton when members (31b), (28b), (37b), (72), (50-53) and (36b) are respectively considered as "housing", "housing port", "shuttle", "shuttle port", "check valve" and "biasing means" as recited. As for claim 16, the "adapted" phrase is given no patentable weight. The tool of Creighton as shown in figures 9-10 is capable of being associated with a straddle packer as recited.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creighton '352. Creighton discloses the invention as claimed except that the "housing" 31b and "shuttle" (37b) of Creighton are one-piece body whereas the claims call for two-piece bodies. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the "housing" or "shuttle" of two separate pieces since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the

art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Without acquiescing to the characterization of the prior art found in the Office Action, or the application of the art to the claims, and in order to move this case along to issuance, Assignee has amended the claims to more particularly point out the claimed invention. Specifically, Assignee has amended claim 1 to include the limitations of dependent claim 6 (previously objected to), cancelled claim 6, and changed the dependency of claim 7 to depend from claim 1. Claim 1 thus includes the limitations of claim 6. Further, claim 15 has been amended to correct "id" to "is." As such, it is believed all pending claims are in condition for allowance.

C. Allowable Subject Matter

Claim 17 is allowed. Claims 6-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The limitations of claim 6 have been added to claim 1, from which claim 6 originally depended, and thus represents claim 6 rewritten in independent form including all the limitations of the base claim. Claim 6 has been cancelled, with the dependency of claim 7 changed to depend from claim 1. Claim 17 was amended to add the word "and."

New claims 26-29 have been added, which depend directly or indirectly from claim 17. These claims substantially replicate claims 2, 3, 4, and 6, (but depend from allowed claim 17); thus, these claims are proper in that no new matter is being inserted into this application. As such, it is believed new claims 26-29 are also in condition for allowance.

D. Specification

6. The disclosure is objected to because of the following informalities: Page 23, line 3, either the word "greater" should be ~~—smaller—~~ or the words "above" and "below" should be changed to ~~—below—~~ and ~~—above—~~, respectively. Appropriate correction is required,

The specification has been amended herein.

E. Drawings

7. The drawings are objected to because parts shown in section in Figure 2 are not properly crosshatched. Further, it is suggested that either the words ~~—Straddle Packer—~~ are added to the reference numeral 10 in figure 2 or the straddle packer denoted by reference numeral 10 in figure 2

is removed to show the open end of the isolation assembly. Corrected drawing sheets in compliance with 37 CFR 1.1.21(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The Figures have been amended pursuant to the cited rules. A "Replacement Sheet" of Figure 2, along with Figure 1, are submitted concurrently. It is noted that cross-hatching and the requested "Straddle Packer" label has added to Figure 2. Assignee notes, however, that while claims 116 and 17 specifically address the straddle packer, claims 1-15, e.g., do not include a limitation to a straddle packer, and as such, Figure 2 represents an illustrative embodiment in which a straddle packer is the downhole tool. See, for example, paragraph [0068] of the present application. Reference numeral 453 has been added to Figure 2.

F. Conclusion

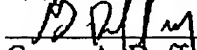
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In view of the above amendment and remarks, Assignee respectfully requests that the Examiner indicate the allowance of all pending claims in the next paper from the Office. The Examiner is invited to contact the undersigned attorney to discuss any issues or questions presented by this paper.

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Respectfully submitted,



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